

BEST AVAILABLE COPY



UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

DN

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/146,069	09/02/98	YOSHIDA T	1232-4467

┌  
MORGAN & FINNEGAN  
345 PARK AVENUE  
NEW YORK NY 10154

WM31/1108

┐  
EXAMINER

POKRZYWA, J

ART UNIT	PAPER NUMBER
2622	

DATE MAILED: 11/08/00

5

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
09/146,069

Applicant(s)

YOSHIDA, Takehiro

Examiner  
Joseph Pokrzywa

Group Art Unit  
2622



- ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

- ☒ Claim(s) 1-25 is/are pending in the application.
- Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-25 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☒ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been
- ☒ received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
- \*Certified copies not received: \_\_\_\_\_
- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- ☒ Notice of References Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☒ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

Art Unit: 2622

## DETAILED ACTION

### *Priority*

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### *Drawings*

2. The drawings were not objected to by the Official Draftsman (see attached PTO-948).

### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. **Claims 16 through 19** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. **Claim 16** recites the limitation "the summarized text" in line 4, the limitation "the summary" in line 5, the limitation "the information" in lines 5 and 6, and the limitation "the first page" in line 6. There is insufficient antecedent basis for these limitations in the claim.

6. **Claim 17** recites the limitation "the number of pages" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Art Unit: 2622

7. *Claim 18* recites the limitation "the Internet communication step" in line 4. There is insufficient antecedent basis for this limitation in the claim.

8. *Claim 19* recites the limitation "the Internet communication step" in lines 5 and 6, and the limitation "the notification step" in line 10. There is insufficient antecedent basis for these limitations in the claim.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

10. **Claims 1 and 9** are rejected under 35 U.S.C. 102(e) as being anticipated by Gordon (U.S. Patent Number 5,608,786).

Regarding *claims 1 and 9*, Gordon discloses a communication apparatus (UniPost access node) and method comprising a means for performing facsimile communication through the Internet (column 8, lines 1 through 44) by dial-up connection (column 6, lines 21 through 33) with a station (computer 12, telephone 29, and facsimile 31 in Fig. 3, or facsimile 62 in Fig. 4), and means for notifying the station (computer 12, telephone 29, and facsimile 31 in Fig. 3, or

Art Unit: 2622

facsimile 62 in Fig. 4) using a PSTN that the facsimile communication through the Internet has been executed (column 7, lines 18 through 66, and column 10, lines 21 through 65).

11. **Claims 1, 2, 9, and 10** are rejected under 35 U.S.C. 102(e) as being anticipated by Ho *et al.* (U.S. Patent Number 5,805,298).

Regarding **claim 1**, Ho discloses a communication apparatus (communications device 100) comprising a means for performing facsimile communication through the Internet (see Figs. 1 and 3) by dial-up connection (column 3, line 53 through column 4, line 6) with a station (destination communication device 100, whereby the communications device retrieves e-mail messages stored in electronic mailboxes 104 or 105), and means for notifying the station (destination communication device 100, used for retrieval of e-mail messages) using a PSTN (PSTN 106, wherein as seen in Fig. 1, the PSTN connects the communication device 100 with the router 107) that the facsimile communication through the Internet has been executed (step 416 of Fig. 4, column 8, lines 18 through 37, wherein a facsimile communication, having been transmitted through the Internet, as seen in Fig. 3, is stored in electronic mailbox 104 or 105, which is then accessed by a communications device 100).

Regarding **claim 2**, Ho discloses a communication apparatus (communications device 100) comprising a means for performing facsimile communication through the Internet (see Figs. 1 and 3) by dial-up connection (column 3, line 53 through column 4, line 6), and means for, when it is notified using a PSTN (PSTN 106, wherein as seen in Fig. 1, the PSTN connects the

Art Unit: 2622

communication device 100 with the router 107) that communication through the Internet has been executed by dial-up connection (step 416 of Fig. 4, column 8, lines 18 through 37), setting up connection to the Internet by dial-up connection (column 7, line 63 through column 8, line 7) and receiving facsimile communication information through the Internet by POP (step 418 in Fig. 4, column 7, lines 54 through 62, and column 8, lines 38 through 50).

Regarding *claim 9*, Ho discloses a communication method (see Figs. 3 and 4) comprising a step of performing facsimile communication through the Internet (see Figs. 1 and 3) by dial-up connection (column 3, line 53 through column 4, line 6) with a station (destination communication device 100, whereby the communications device retrieves e-mail messages stored in electronic mailboxes 104 or 105), and a step of notifying the station (destination communication device 100, used for retrieval of e-mail messages) using a PSTN (PSTN 106, wherein as seen in Fig. 1, the PSTN connects the communication device 100 with the router 107) that the facsimile communication through the Internet has been executed (step 416 of Fig. 4, column 8, lines 18 through 37, wherein a facsimile communication, having been transmitted through the Internet, as seen in Fig. 3, is stored in electronic mailbox 104 or 105, which is then accessed by a communications device 100).

Regarding *claim 10*, Ho discloses a control method (see Figs. 3 and 4) for a communication apparatus (communications device 100) comprising a step of performing facsimile communication through the Internet (see Figs. 1 and 3) by dial-up connection (column 3, line 53 through column 4, line 6), and a step of, when it is notified using a PSTN (PSTN 106, wherein as

Art Unit: 2622

seen in Fig. 1, the PSTN connects the communication device 100 with the router 107) that communication through the Internet has been executed by dial-up connection (step 416 of Fig. 4, column 8, lines 18 through 37), setting up connection to the Internet by dial-up connection (column 7, line 63 through column 8, line 7) and receiving facsimile communication information through the Internet by POP (step 418 in Fig. 4, column 7, lines 54 through 62, and column 8, lines 38 through 50).

12. **Claims 12, 13, 18, and 19** are rejected under 35 U.S.C. 102(a) as being anticipated by Kulakowski (WIPO Publication Number WO 97/10,668).

Regarding *claim 12*, Kulakowski discloses a communication apparatus capable of facsimile communication through the Internet by dial-up connection (see abstract, and page 13, lines 11 through 36), comprising means for performing dial-up connection from a station A (facsimile 12 and interface 10, or facsimile 14, seen in Figs. 1 through 3) to an Internet service provider (service provider 18) to execute communication with a station B (facsimile 24 and interface 26, or facsimile 28, seen in Figs. 1 through 3) having a TCP/IP address through the Internet (page 2, lines 12 through 24, and page 13, lines 11 through 36), and means for, when communication by the Internet communication execution means has been executed, calling the station B (facsimile 28) from the station A (facsimile 14, wherein facsimile 14 is calling facsimile 28 *when* the execution means has performed the dial-up connection to execute communication with facsimile 28, seen on page 12, lines 5 and 6, and step 68 of Fig. 5) using a general public

Art Unit: 2622

network (telephone connections 16 and 30, page 8, lines 3 through 23) to transmit information representing that facsimile communication has been executed through the Internet and description information of the facsimile communication executed through the Internet (page 18, lines 16 through 31).

Regarding *claim 13*, Kulakowski discloses the apparatus discussed above in claim 12, and further teaches that the description information is summarized text representing a summary of facsimile communication (page 18, lines 21 through 23, wherein the sender's e-mail address is summarized text).

Regarding *claim 18*, Kulakowski discloses a control method (see Figs. 5, 7, and 8) for a communication apparatus capable of facsimile communication through the Internet by dial-up connection (see abstract, and page 13, lines 11 through 36), comprising a step of performing dial-up connection from a station A (facsimile 12 and interface 10, or facsimile 14, seen in Figs. 1 through 3) to an Internet service provider (service provider 18) to execute communication with a station B (facsimile 24 and interface 26, or facsimile 28, seen in Figs. 1 through 3) having a TCP/IP address through the Internet (page 2, lines 12 through 24, and page 13, lines 11 through 36), and a step of, when communication has been executed in the Internet communication execution step, calling the station B (facsimile 28) from the station A (facsimile 14, wherein facsimile 14 is calling facsimile 28 *when* the execution means has performed the dial-up connection to execute communication with facsimile 28, seen on page 12, lines 5 and 6, and step 68 of Fig. 5) using a general public network (telephone connections 16 and 30, page 8, lines 3

Art Unit: 2622

through 23) to transmit information representing that facsimile communication has been executed through the Internet and description information of the facsimile communication executed through the Internet (page 18, lines 16 through 31).

Regarding *claim 19*, Kulakowski discloses a computer-readable storage medium (memory 34) which stores a program for controlling a communication apparatus (page 9, line 31 through page 10, line 3) capable of facsimile communication through the Internet by dial-up connection (see abstract, and page 13, lines 11 through 36), comprising code for a step of performing dial-up connection from a station A (facsimile 12 and interface 10, or facsimile 14, seen in Figs. 1 through 3) to an Internet service provider (service provider 18) to execute communication with a station B (facsimile 24 and interface 26, or facsimile 28, seen in Figs. 1 through 3) having a TCP/IP address through the Internet (page 2, lines 12 through 24, and page 13, lines 11 through 36), and code for a step of, when communication has been executed in the Internet communication execution step, calling the station B (facsimile 28) from the station A (facsimile 14, wherein facsimile 14 is calling facsimile 28 *when* the execution means has performed the dial-up connection to execute communication with facsimile 28, seen on page 12, lines 5 and 6, and step 68 of Fig. 5) using a general public network (telephone connections 16 and 30, page 8, lines 3 through 23) to transmit information representing that facsimile communication has been executed through the Internet and description information of the facsimile communication executed through the Internet (page 18, lines 16 through 31).

Art Unit: 2622

13. **Claim 20** is rejected under 35 U.S.C. 102(e) as being anticipated by Foladare *et al.* (U.S. Patent Number 5,905,777).

Regarding **claim 20**, Foladare discloses a communication apparatus (e-mail server 60) comprising means for transmitting data (through line 63 and telephone network 64 to facsimile 72 or 72', or personal computer 70 or 70'), and means (paging system 66, or cable TV system 66') for notifying, by a method different from that of the transmission means, that the data has been transmitted (column 6, lines 1 through 32, and column 7, lines 31 through 51).

14. **Claims 20 through 22, 24, and 25** are rejected under 35 U.S.C. 102(e) as being anticipated by Quinn (U.S. Patent Number 5,944,786).

Regarding **claim 20**, Quinn discloses a communication apparatus (e-mail server 12, see Figs. 1 through 4) comprising means for transmitting data (e-mail transmitted and received using computers 16 and 18, column 5, lines 40 through 57, and column 6, lines 1 through 16), and means for notifying (mail notification server 40), by a method different from that of the transmission means, that the data has been transmitted (column 6, lines 10 through 22).

Regarding **claim 21**, Quinn discloses the apparatus discussed above in claim 20, and further teaches that the transmission means transmits the data through the Internet (column 5, lines 37 through 39), and the notification means transmits notification through a public telephone network (column 5, lines 28 through 37).

Art Unit: 2622

Regarding *claim 22*, Quinn discloses a communication apparatus (e-mail server 12, see Figs. 1 through 4) comprising first means for sending data via a first communication network (e-mail data transmitted and received using computers 16 and 18 over data communication means 20, column 5, lines 40 through 57, and column 6, lines 1 through 16), second means (mail notification server 40) for sending data via second communication network (column 5, lines 24 through 37, and column 6, lines 10 through 22), and third means for controlling the first means and the second means (specialized forwarding software 28), wherein the third means controls the second means so as to send data corresponding to sending operation of the first means (column 5, line 58 through column 6, line 22).

Regarding *claim 24*, Quinn discloses the apparatus discussed above in claim 22, and further teaches that the second communication network is a telephone network (column 5, lines 28 through 37).

Regarding *claim 25*, Quinn discloses the apparatus discussed above in claim 22, and further teaches that the data sent by the second means is a part of data sent by the first means (column 10, lines 23 through 38).

Art Unit: 2622

***Claim Rejections - 35 USC § 103***

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. **Claims 1, 2, and 4 through 11** are rejected under 35 U.S.C. 103(a) as being unpatentable over Cooper *et al.* (U.S. Patent Number 6,052,442) in view of Kulakowski (WIPO Publication Number WO 97/10,668).

Regarding **claim 1 and 9**, Cooper discloses a communication apparatus (Internet answering machine seen in Fig. 1) and method comprising a means for performing facsimile communication (column 6, lines 38 through 40) through the Internet (column 1, lines 41 through 56) by dial-up connection (step 74 in Fig. 3, and step 94 in Fig. 5, column 10, lines 40 through 43) with a station (display 16), and means for notifying the station using a telephone line (5, column 4, lines 30 through 47) that the facsimile communication through the Internet has been executed (step 54 in Fig. 2-1, or step 80 in Fig. 3, column 8, line 21 through column 9, line 13, and seen in Fig. 4).

However, Cooper fails to specifically teach of notifying the station **using a PSTN** that the facsimile communication through the Internet has been executed. Kulakowski discloses a communication apparatus (see Figs. 1 through 3, interface apparatus 26) comprising a means for

Art Unit: 2622

performing facsimile communication through the Internet by dial-up connection (see abstract, and page 13, lines 11 through 36) with a station (display 43), and means for notifying the station using a PSTN (telephone connections 16 and 30, being a PSTN, page 8, lines 3 through 23) that the facsimile communication through the Internet has been executed (process of Fig. 5, steps 76 through 98, and page 18, lines 16 through 26). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Kulakowski's teachings in Cooper's system. Cooper's system would conform with industry standards, and would easily be modified to incorporate Kulakowski's teachings, as using a PSTN is widely known and used throughout the art to connect facsimile devices together or to an Internet service provider, as recognized by Kulakowski.

Regarding *claim 2 and 10*, Cooper discloses a communication apparatus (Internet answering machine seen in Fig. 1) and a control method for the communication apparatus comprising a means for performing facsimile communication (column 6, lines 38 through 40) through the Internet (column 1, lines 41 through 56) by dial-up connection (step 74 in Fig. 3, and step 94 in Fig. 5, column 10, lines 40 through 43), and means for, when it is notified using a telephone line (5, column 4, lines 30 through 47) that communication through the Internet has been executed by dial-up connection (step 54 in Fig. 2-1, or step 80 in Fig. 3, column 8, lines 21 through 38), setting up connection to the Internet by dial-up connection (step 94 in Fig. 5, column 10, lines 25 through 55) and receiving facsimile communication information through the Internet by POP (column 1, lines 41 through 67, and column 10, lines 43 through 64).

Art Unit: 2622

However, Cooper fails to specifically teach of notifying the station using a PSTN that communication through the Internet has been executed. Kulakowski discloses a communication apparatus (see Figs. 1 through 3, interface apparatus 26) comprising a means for performing facsimile communication through the Internet by dial-up connection (see abstract, and page 13, lines 11 through 36) with a station (display 43), and means for notifying the station using a PSTN (telephone connections 16 and 30, being a PSTN, page 8, lines 3 through 23) that the facsimile communication through the Internet has been executed (process of Fig. 5, steps 76 through 98, and page 18, lines 16 through 26). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Kulakowski's teachings in Cooper's system. Cooper's system would conform with industry standards, and would easily be modified to incorporate Kulakowski's teachings, as using a PSTN is widely known and used throughout the art to connect facsimile devices together or to an Internet service provider, as recognized by Kulakowski.

Regarding *claim 4*, Cooper and Kulakowski disclose the apparatus discussed above in claim 2, and Cooper further teaches of a means for registering a time of execution of POP processing on the basis of a user operation (step 70 in Fig. 3, column 8, lines 14 through 20), and wherein the reception means set up connection to the Internet at the registered time and receive the facsimile communication information through the Internet by POP ("yes" branch of step 72, leading to steps 74, 76, and 80, column 8, lines 20 through 38).

Art Unit: 2622

Regarding *claim 5*, Cooper discloses a communication apparatus (Internet answering machine seen in Fig. 1) capable of facsimile communication (column 6, lines 38 through 40) through the Internet (column 1, lines 41 through 56) by dial-up connection (step 74 in Fig. 3, and step 94 in Fig. 5, column 10, lines 40 through 43), comprising a means (display 16) for, when it is notified using a telephone line (5, column 4, lines 30 through 47) that communication through the Internet has been executed (step 54 in Fig. 2-1, or step 80 in Fig. 3, column 8, lines 21 through 38), displaying information representing that communication through the Internet has been executed (see Fig. 4, column 8, line 54 through column 9, line 13) and station address information (column 9, lines 7 through 13) of a calling party (see step 90 in Fig. 3, column 8, lines 44 through 49), and a means for determining on the basis of selection by a user whether the apparatus is to set up connection to the Internet by dial-up connection (step 94 in Fig. 5, column 10, lines 25 through 55) to receive facsimile communication information through the Internet by POP (column 1, lines 41 through 67, and column 10, lines 43 through 64).

However, Cooper fails to specifically teach of notifying **using a PSTN** that communication through the Internet has been executed. Kulakowski discloses a communication apparatus (see Figs. 1 through 3, interface apparatus 26) capable of facsimile communication through the Internet by dial-up connection (see abstract, and page 13, lines 11 through 36), comprising a means (display 43) for, when it is notified using a PSTN (telephone connections 16 and 30, being a PSTN, page 8, lines 3 through 23) that communication through the Internet has been executed (process of Fig. 5, steps 76 through 98), displaying information representing that

Art Unit: 2622

communication through the Internet has been executed and station address information of a calling party (page 18, lines 16 through 26), and a means for determining on the basis of selection by a user (page 18, lines 25 and 26) whether the apparatus is to receive facsimile communication information through the Internet by POP (page 2, lines 8 through 24). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Kulakowski's teachings in Cooper's system. Cooper's system would conform with industry standards, and would easily be modified to incorporate Kulakowski's teachings, as using a PSTN is widely known and used throughout the art to connect facsimile devices together or to an Internet service provider, as recognized by Kulakowski.

Regarding *claim 6*, Cooper and Kulakowski disclose the apparatus discussed above in claim 5, and Cooper further teaches of a means for registering whether, when it is notified using the PSTN (being obvious in view of Kulakowski, discussed above) that communication through the Internet has been executed (step 90 of Fig. 3), dial-up connection is to be immediately performed on the basis of a station address of the calling party (column 9, lines 40 through 49, and column 5, lines 54 through 66, step 46 in Fig. 2-1) to receive the facsimile communication information through the Internet by POP (column 1, lines 41 through 67, and column 10, lines 43 through 64).

Regarding *claim 7*, Cooper and Kulakowski disclose the apparatus discussed above in claim 5, and Cooper further teaches that when dial-up connection is performed to receive the facsimile communication information through the Internet (step 94 of Fig. 5), all pieces of

Art Unit: 2622

facsimile communication information received by a service provider are received (column 10, lines 40 through 64).

Regarding *claim 8*, Cooper and Kulakowski disclose the apparatus discussed above in claim 5, and Cooper further teaches of display means (display 16) for, when it is notified using the PSTN (being obvious in view of Kulakowski, discussed above) that communication through the Internet has been executed (step 90 of Fig. 3), displaying a list of communication management information independently of communication management information associated with normal transmission/reception (see Fig. 4, column 9, lines 7 through column 10, line 15), and means (display 16) for displaying, in correspondence with the notification, whether reception of the facsimile communication information from the service provider is complete (column 10, line 65 through column 11, line 14).

Regarding *claim 11*, Cooper discloses a control method for a communication apparatus (Internet answering machine seen in Fig. 1) capable of facsimile communication (column 6, lines 38 through 40) through the Internet (column 1, lines 41 through 56) by dial-up connection (step 74 in Fig. 3, and step 94 in Fig. 5, column 10, lines 40 through 43), comprising a display step (using display 16) of, when it is notified using a telephone line (5, column 4, lines 30 through 47) that communication through the Internet has been executed (step 54 in Fig. 2-1, or step 80 in Fig. 3, column 8, lines 21 through 38), displaying information representing that communication through the Internet has been executed (see Fig. 4, column 8, line 54 through column 9, line 13) and station address information (column 9, lines 7 through 13) of a calling party (see step 90 in

Art Unit: 2622

Fig. 3, column 8, lines 44 through 49), and a step of determining on the basis of selection by a user whether the apparatus is to set up connection to the Internet by dial-up connection (step 94 in Fig. 5, column 10, lines 25 through 55) to receive facsimile communication information through the Internet by POP (column 1, lines 41 through 67, and column 10, lines 43 through 64).

However, Cooper fails to specifically teach of notifying **using a PSTN** that communication through the Internet has been executed. Kulakowski discloses a control method for a communication apparatus (see Figs. 1 through 3, interface apparatus 26) capable of facsimile communication through the Internet by dial-up connection (see abstract, and page 13, lines 11 through 36), comprising a display step (using display 43) of, when it is notified using a PSTN (telephone connections 16 and 30, being a PSTN, page 8, lines 3 through 23) that communication through the Internet has been executed (process of Fig. 5, steps 76 through 98), displaying information representing that communication through the Internet has been executed and station address information of a calling party (page 18, lines 16 through 26), and a step of determining on the basis of selection by a user (page 18, lines 25 and 26) whether the apparatus is to receive facsimile communication information through the Internet by POP (page 2, lines 8 through 24). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Kulakowski's teachings in Cooper's system. Cooper's system would conform with industry standards, and would easily be modified to incorporate Kulakowski's teachings, as using a PSTN is widely known and used throughout the art to connect facsimile devices together or to an Internet service provider, as recognized by Kulakowski.

Art Unit: 2622

17. **Claim 3** is rejected under 35 U.S.C. 103(a) as being unpatentable over Cooper *et al.* (U.S. Patent Number 6,052,442) in view of Kulakowski (WIPO Publication Number WO 97/10,668), and further in view of Obhan (U.S. Patent Number 5,875,302).

Regarding *claim 3*, Cooper and Kulakowski disclose the system discussed above in claim 1, but fail to specifically teach of a means for selecting on the basis for a user operation whether the communication is an important communication, and wherein when the important communication is not selected, notification means do not notify the station using a PSTN that the facsimile communication through the Internet has been executed. Obhan discloses a communication apparatus (server 150) comprising a means for performing a communication through the Internet (e-mail communication) with a station (users 112, column 4, line 65 through column 5, line 13), and a means for notifying the station (notification interface 106) that the communication through the Internet has been executed (column 17, lines 5 through 37). Further, Obhan teaches of a means for selecting on the basis for a user operation whether the communication is an important communication (notification priority 206, column 6, lines 28 through 36), and wherein when the important communication is not selected, notification means do not notify the station that the communication through the Internet has been executed (column 6, line 66 through column 7, line 9). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Obhan's teachings in Cooper and Kulakowski's system, therein including a means for selecting on the basis for a user operation whether the communication is an important communication, and wherein when the important

Art Unit: 2622

communication is not selected, notification means do not notify the station using a PSTN that the facsimile communication through the Internet has been executed. The system of Cooper and Kulakowski would become more efficient with the addition of Obhan's teachings, as notifications would only be sent when high priority is designated, therein not tying up the system with unnecessary communications over the telephone network.

18. **Claims 14 through 16** are rejected under 35 U.S.C. 103(a) as being unpatentable over Kulakowski (WIPO Publication Number WO 97/10,668) in view of Bobo, II (U.S. Patent Number 5,675,507).

Regarding *claim 14*, Kulakowski discloses the apparatus discussed above in claim 12, but fails to specifically teach if the description information is information of a first page of facsimile information transmitted through the Internet. Bobo discloses a communication apparatus capable of facsimile communication through the Internet by dial-up connection (see Fig. 1), comprising means for performing dial-up connection from a station A (facsimile 24) to an Internet service provider (column 6, lines 44 through 56) to execute communication with a station B (personal computer 32), and means for, when communication by the communication execution means has been executed (process of Fig. 2), calling the station B (step 56, column 7, lines 6 through 8) to transmit information representing that facsimile communication has been executed and description information of the facsimile communication executed through the Internet (column 8, line 22 through column 9, line 37). Further, Bobo teaches that the description information is information

Art Unit: 2622

of a first page of facsimile information transmitted through the Internet (column 9, lines 2 through 17). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Bobo's teachings in Kulakowski's system. Kulakowski's system would become more user friendly if adapted to incorporate Bobo's teachings, as the user would be able to quickly scroll through cover pages of transmitted messages, without downloading the entire message.

Regarding *claim 15*, Kulakowski discloses the apparatus discussed above in claim 12, and further teaches that the notification means further transmits a communication time (page 18, lines 21 through 23), but fails to specifically teach of transmitting the number of pages of facsimile information transmitted through the Internet. Bobo discloses a communication apparatus capable of facsimile communication through the Internet by dial-up connection (see Fig. 1), comprising means for performing dial-up connection from a station A (facsimile 24) to an Internet service provider (column 6, lines 44 through 56) to execute communication with a station B (personal computer 32), and means for, when communication by the communication execution means has been executed (process of Fig. 2), calling the station B (step 56, column 7, lines 6 through 8) to transmit information representing that facsimile communication has been executed and description information of the facsimile communication executed through the Internet (column 8, line 22 through column 9, line 37). Further, Bobo teaches that the notification means further transmits the number of pages of facsimile information transmitted through the Internet (column 8, lines 53 through 60) and a communication time (column 8, lines 53 through 60). Therefore, it would have

Art Unit: 2622

been obvious to a person of ordinary skill in the art at the time the invention was made to include Bobo's teachings in Kulakowski's system. Kulakowski's system would become more user friendly if adapted to incorporate Bobo's teachings, as the user would be able to determine display options based on the number of pages of transmitted facsimile messages, and the communication time, without downloading the entire message.

Regarding *claim 16*, Kulakowski discloses the apparatus discussed above in claim 12, but fails to specifically teach of a means for selecting, as the description information to be transmitted, one of summarized text representing a summary of facsimile communication and information of a first page of the facsimile information transmitted through the Internet. Bobo discloses a communication apparatus capable of facsimile communication through the Internet by dial-up connection (see Fig. 1), comprising means for performing dial-up connection from a station A (facsimile 24) to an Internet service provider (column 6, lines 44 through 56) to execute communication with a station B (personal computer 32), and means for, when communication by the communication execution means has been executed (process of Fig. 2), calling the station B (step 56, column 7, lines 6 through 8) to transmit information representing that facsimile communication has been executed and description information of the facsimile communication executed through the Internet (column 8, line 22 through column 9, line 37). Further, Bobo teaches of a means for selecting, as the description information to be transmitted, one of the summarized text representing the summary of facsimile communication (column 8, lines 53 through 63) and the information of the first page of the facsimile information transmitted through

Art Unit: 2622

the Internet (column 9, lines 2 through 30). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Bobo's teachings in Kulakowski's system. Kulakowski's system would become more user friendly if adapted to incorporate Bobo's teachings, as the user would be able to determine display options, without downloading the entire message.

19. **Claim 17** is rejected under 35 U.S.C. 103(a) as being unpatentable over Kulakowski (WIPO Publication Number WO 97/10,668) in view of Wegner *et al.* (U.S. Patent Number 5,712,907).

Regarding *claim 17*, Kulakowski discloses the apparatus discussed above in claim 12, and further teaches of a means for transmitting the facsimile information from the station A to the station B through the general public network without performing communication by the Internet communication execution means (see Fig. 5, "no" branch of step 71, leading to steps 100 through 110, page 15, lines 18 through 32). However, Kulakowski fails to teach of transmitting the facsimile information through the general public network when the number of pages of the facsimile information to be transmitted from the station A to the station B through the Internet is not more than a predetermined value. Wegner discloses a communication apparatus capable of facsimile communication through the Internet by dial-up connection (column 4, lines 7 through 11), comprising means for performing dial-up connection from a station A (message communicating device 2s) to an Internet service provider (network node 6s) to execute

Art Unit: 2622

communication with a station B (message communicating devices 1r, 2r, or 3r) having a TCP/IP address through the Internet (column 8, lines 31 and 32, and column 13, line 64 through column 14, line 3), and means for, when communication by the Internet communication execution means has been executed, calling the station B (recipient 8r in Fig. 7a) using a general public network (PSTN 5) to transmit information representing that facsimile communication has been executed through the Internet and description information of the facsimile communication executed through the Internet (column 3, lines 52 and 53). Further, Wegner teaches of a means (least cost routing processor 103) for, when the number of pages of the facsimile information to be transmitted from the station A to the station B through the Internet is not more than a predetermined value (column 10, lines 21 through 23, and column 12, lines 59 through 62, wherein the number of pages of the message corresponds to the size of the message), transmitting the facsimile information from the station A to the station B through the general public network (PSTN 5) without performing communication by the Internet communication execution means (column 3, lines 54 65, and column 7, lines 25 through 62). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Wegner's teachings in Kulakowski's system, thereby having a means for transmitting the facsimile information from the station A to the station B through the general public network without performing communication by the Internet communication execution means when the number of pages of the facsimile information to be transmitted from the station A to the station B through the Internet is not more than a predetermined value. Kulakowski's system would become more efficient if adapted to incorporate

Art Unit: 2622

Wegner's teachings, as the most cost effective transmission would be selected to route the facsimile message.

20. **Claim 23** is rejected under 35 U.S.C. 103(a) as being unpatentable over Quinn (U.S. Patent Number 5,944,786).

Regarding *claim 23*, Quinn discloses the apparatus discussed above in claim 22, but fails to specifically teach of the first communication network (data communication means 20) being a facsimile communication network. However, Quinn does teach that the first communication network may be any appropriate means of communicating data (column 5, lines 28 through 39). As is widely known throughout the art, facsimile communication is a well known method of communicating data. Further, Quinn teaches of the sending and receiving computers (16 and 18) being arranged to transfer data signals across the data communication means (20), which can be a standard telephone system (column 5, lines 24 through 37). As is widely known throughout the art, computers commonly have facsimile capabilities, being attachments to e-mail, or through standard telephone lines as facsimile communications. Because of this, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have the first communication network of Quinn be a facsimile communication network. Quinn's system would become more versatile by being modified to include a facsimile communication network, as user's would have more options to transmit data between computers.

Art Unit: 2622

***Citation of Pertinent Prior Art***

21. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

**Wang** (U.S. Patent Number 5,956,521) discloses a system which notifies e-mail recipients of messages which arrived at a regional server;

**Okumura *et al.*** (U.S. Patent Number 5,293,250) discloses a system for notifying a destination terminal that electronic mail has reached a host computer;

**Geshwind** (WIPO Publication Number WO 96/41,463) discloses a system of performing facsimile communication over the Internet.

Art Unit: 2622

*Conclusion*

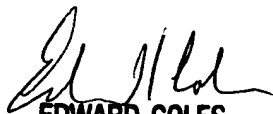
22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe Pokrzywa whose telephone number is (703) 305-0146. The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 4:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles, can be reached on (703) 305-4712. The fax phone number for this Group is (703) 306-5406.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-4700/4750.

Joseph R. Pokrzywa

November 3, 2000

  
EDWARD COLES  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600